

REMARKS

The Official Action mailed July 6, 2011, has been received and its contents carefully noted. This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time. Accordingly, the Applicant respectfully submits that this response is being timely filed.

The Applicant notes with appreciation the consideration of the Information Disclosure Statements filed on September 27, 2006; January 15, 2009; February 12, 2010 and January 28, 2011.

Claims 1-27 were pending in the present application prior to the above amendment. Claims 10 and 26 have been amended to better recite the features of the present invention. Accordingly, claims 1-27 are now pending in the present application, of which claims 1, 6, 9, 10 and 13 are independent. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

Paragraph 3 of the Official Action rejects claims 1-8, 20, 21, 23 and 24 as obvious based on the combination of U.S. Publication No. 2004/0082296 to Twitchell and U.S. Patent No. 6,774,470 to Yagi. Paragraph 4 of the Official Action rejects claims 9, 11, 13-19, 25 and 27 as obvious based on the combination of Twitchell, Yagi and U.S. Publication No. 2004/0164302 to Arai. Paragraph 5 of the Official Action rejects claims 10-12 and 22 as obvious based on the combination of Twitchell and Arai. Paragraph 6 of the Official Action rejects claim 26 as obvious based on the combination of Twitchell, Arai and Yagi. The Applicant respectfully traverses the rejection because the Official Action has not made a *prima facie* case of obviousness and/or that a *prima facie* case of obviousness cannot be maintained against the independent claims of the present application, as amended.

As stated in MPEP §§ 2142-2144.04, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some reason, either

in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some reason to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. “The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.” In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

With respect to independent claims 1, 6, 9, 10 and 13, the prior art, either alone or in combination, does not teach or suggest all the features of the independent claims. As a preliminary matter, independent claim 10 has been amended to recite “wherein the first resonance circuit comprises a first antenna coil and a first capacitor” and “wherein the second resonance circuit comprises a second antenna coil and a second capacitor” as in claim 1. Dependent claim 26 is accordingly revised for antecedence.

Although the Official Action admits that Yagi fails to teach first and second resonance circuits, it is asserted that Yagi teaches a resonance circuit (1, Fig. 3) comprising (or consisting of) an antenna coil (3, Fig. 3) and a capacitor (2, Fig. 3) provided on a first packing material. The Applicant respectfully disagrees. Reference numeral 1 of Yagi is a substrate of a plastic material. Reference numeral 2 is an **IC chip**. Reference numeral 3 is a coil antenna pattern. Thus, the device of Yagi may be a **non-contact data carrier**, but does not appear to be a resonance circuit as claimed comprising (consisting of) an antenna coil and a capacitor on a first packing material for packing a product provided with a semiconductor device.

It is also noted that Fig. 3 of Yagi is merely a comparative example, while Figs. 1 and 2 show the invention of Yagi. In Figs. 1 and 2, reference numeral 11 is a semiconductor device, and reference numeral 12 is a coil antenna 12 that surrounds the semiconductor device 11, and which is electrically connected to the semiconductor device 11 via wires 14. From this, Figs. 1 and 2 of Yagi also do not appear to teach or suggest the claimed resonance circuit and instead appear to show an antenna directly formed on a non-contact data carrier having a semiconductor device (IC chip).

In view of the above, at best Yagi's device may correspond to the RFT 130 of Twitchell, Jr., which also contains a semiconductor device. However, there does not appear to be any rationale provided to replace the LPRF 110 and/or the MLG 180 of Twitchell, Jr. with Yagi's non-contact data carrier.

Further, no rationale has been given that would have predictably led one skilled in the art to provide **only** the booster antenna or the resonance circuit of Yagi on a first package as claimed, because Yagi teaches that the IC chip, the coil antenna pattern, and the booster antenna and/or the resonance circuit are integrated.

Finally, with respect to independent claims 1, 6 and 10, the asserted combination fails to teach or suggest the specific communication between resonance circuits.

As set forth in MPEP § 2142, the examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. In this regard, the Supreme Court in KSR noted that the analysis supporting a rejection under 35 U.S.C. § 103 should be made explicit (KSR International Co. v. Teleflex Inc., 550 U.S. 398, 82 USPQ2d 1385 (2007)). The Court quoting In re Kahn (441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)) stated that “[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” KSR, 550 U.S. at ___, 82 USPQ2d at 1396. This has not been done.

Because Twitchell, Jr. and/or Yagi and Arai do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained with respect to independent claims 1, 6, 9, 10 and 13. Therefore, Applicant believes the rejections of claims 1, 6, 9, 10 and 13 and claims dependent therefrom are not proper.

Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

The Commissioner is hereby authorized to charge fees under 37 C.F.R. §§ 1.16, 1.17, 1.20(a), 1.20(b), 1.20(c), and 1.20(d) (except the Issue Fee) which may be required now or hereafter, or credit any overpayment to Deposit Account No. 50-2280.

Respectfully submitted,


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